



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/720,952

11/24/2003

Craig L. Reding

03-1019

5277

25537 7590 12/22/2008

VERIZON
PATENT MANAGEMENT GROUP
1320 North Court House Road
9th Floor
ARLINGTON, VA 22201-2909

EXAMINER

ELAHEE, MD S

ART UNIT

PAPER NUMBER

2614

NOTIFICATION DATE

DELIVERY MODE

12/22/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@verizon.com

Office Action Summary	Application No. 10/720,952	Applicant(s) REDING ET AL.	
	Examiner MD S. ELAHEE	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on filed on 09/04/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/21/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 09/04/2008. Claims 1-21 are pending.

Response to Arguments

2. Applicant's arguments filed in 09/04/2008 remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-12 of co-pending application no. 10/720,920. Because claim in the pending application is broader than the one in co-pending application, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as

Art Unit: 2614

obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application are the same as claim 1 of the co-pending application except receiving a notification at a server.

5. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending application no. 10/858,973. Because claim in the pending application is broader than the one in co-pending application, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application are the same as claim 1 of the co-pending application except displaying step.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-4 and 7-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abburi (U.S. Patent No. 7,130,390) in view of Major et al. (U.S. Patent No. 7,209,955).

Regarding claims 1, 12, 19, with respect to Figures 1, 2 and 4, Abburi teaches a method for providing a notification to a telephone user having a plurality of devices including a preferred device, comprising:

receiving information indicating incoming data directed to one of a plurality of devices of the user, the data being in the form of one of a plurality of data types (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.6, lines 24-41); and

Abburi further teaches transmitting the notification to the user's preferred device, the notification including an identification of the data type of the incoming data (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.6, lines 24-41).

However, Abburi does not specifically teach generating a notification by identifying, from the plurality of data types, a data type of the incoming data. Major teaches generating a notification by identifying, from the plurality of data types, a data type of the incoming data (fig.6; col.10, line 61-col.11, line 25, col.12, lines 25-49, col.18, line 53-col.19, line 34, col.20, lines 45-64). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abburi to incorporate the feature of generating a notification by identifying, from the plurality of data types, a data type of the incoming data in Abburi's invention as taught by Major. The motivation for the modification is to do so in order to provide

Art Unit: 2614

incoming messages based on choice of a user such that the user can easily be informed important message from a particular person.

Regarding claim 2, Abburi, as applied to claim 1, teaches receiving user selection of the preferred device (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.6, lines 24-41).

Regarding claim 3, Abburi, as applied to claim 1, teaches that receiving a user selection of a time period during which notifications are to be transmitted to the preferred device (col.5, lines 45-61).

Regarding claim 4, Abburi, as applied to claim 1, teaches that receiving a user selection of a device for which notifications are to be transmitted to the preferred device (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62).

Regarding claim 7, Abburi, as applied to claim 1, teaches receiving user specifications of a preferred device for receiving notifications based on at least one of the time of day or calling party (col.5, lines 45-61).

Regarding claim 8, Abburi, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a wireless phone capable of displaying text messages (col.4, lines 35-62, col.8, lines 48-54).

Regarding claim 9, Abburi, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a landline phone (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62).

Regarding claim 10, Abburi, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a desktop or laptop computer (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62).

Regarding claim 11, Abburi, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a handheld device (col.4, lines 35-62, col.8, lines 48-54).

Regarding claim 13, Abburi, as applied to claim 12, teaches that a database for storing identifications of calling parties from whom notifications are transmitted to the preferred device (col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.10, line 12-col.11, line 3).

Regarding claim 14, Abburi, as applied to claim 13, teaches that the database stores times during which notifications are transmitted to the preferred device (col.5, lines 45-61).

Claim 15 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Abburi teaches receiving information from a calling party calling one of the

Art Unit: 2614

plurality of devices (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.6, lines 24-41); and

Abburi further teaches generating a signal to the preferred device to display a real-time notification (col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.6, lines 24-41, col.9, lines 28-41).

Regarding claim 16, Abburi, as applied to claim 15, teaches that generating the notification includes the name and phone number of the calling party (col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.10, line 12-col.11, line 3).

Regarding claim 17, Abburi, as applied to claim 16, teaches that the notification includes the date and time, type of communication, and access method (col.5, lines 45-61).

Regarding claim 18, Abburi, as applied to claim 17, teaches that generating the notification further includes a voice mail message (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62).

9. Claims 5, 6, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abburi in view of Major et al. further in view of Hellebust et al. (U.S. Patent No. 6,628,194).

Regarding claims 5 and 20, Abburi, as applied to claims 1 and 19, in view of Major does not specifically teach receiving a user selection of calling parties from which notifications are to

Art Unit: 2614

be transmitted to the preferred device. Hellebust teaches receiving a user selection of calling parties from which notifications are to be transmitted to the preferred device (col.1, lines 42-57, col.2, lines 64-67, col.3, lines 1-13). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abburi in view of Major to incorporate the feature of receiving a user selection of calling parties from which notifications are to be transmitted to the preferred device in Abburi's invention in view of Major's invention as taught by Hellebust. The motivation for the modification is to do so in order to filter incoming messages based on choice such that the user can easily informed important messages from a particular person.

Claims 6 and 21 are rejected for the same reasons as discussed above with respect to claims 5 and 17.

10. Claims 1, 12, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huna et al. (U.S. Pub. No. 2001/0012286) in view of Abburi (U.S. Patent No. 7,130,390).

Regarding claims 1, 12, 19, with respect to Figures 1-3, 6, 8 and 11-14, Huna teaches a method for providing a notification to a telephone user including a preferred device, comprising:

receiving information indicating incoming data directed to one of a plurality of devices of the user, the data being in the form of one of a plurality of data types (abstract; page 2, paragraphs 0016-0020, page 3, paragraphs 0042, 0043, page 4, paragraph 0047, page 6, paragraphs 0070-0072, page 7, paragraphs 0084, 0086, 0087);

Huna further teaches generating a notification by identifying, from the plurality of data types, a data type of the incoming data (abstract; page 2, paragraphs 0016-0020, page 3, paragraphs 0042, 0043, page 4, paragraph 0047, page 6, paragraphs 0070-0072, page 7, paragraphs 0084, 0086, 0087); and

Huna further teaches transmitting the notification to the user's preferred device, the notification including an identification of the data type of the incoming data (abstract; page 2, paragraphs 0016-0020, page 3, paragraphs 0042, 0043, page 4, paragraph 0047, page 6, paragraphs 0070-0072, page 7, paragraphs 0084, 0086, 0087).

Huna further teaches that receiving alert depend on user's choice of type of device he desires to receive the alert (page 7, paragraph 0092). However, Huna does not specifically teach a telephone user having a plurality of devices. Abburi teaches a telephone user having a plurality of devices (abstract; col.2, lines 24-44, 66, 67, col.3, lines 1-19, col.4, lines 35-62, col.6, lines 24-41). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Huna to incorporate a telephone user having a plurality of devices in Huna's invention as taught by Abburi. The motivation for the modification is to do so in order to receive notification messages in different types of user devices such that the user can receive notification whenever he is with a particular type of device at his own choice.

Claim 15 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Huna teaches receiving information from a calling party calling one of the plurality of devices (abstract; page 2, paragraphs 0016-0020, page 3, paragraphs 0042, 0043, page 4, paragraph 0047, page 6, paragraphs 0070-0072, page 7, paragraphs 0084, 0086, 0087); and

Huna further teaches generating a signal to the preferred device to display a real-time notification (fig.13, item 1318; page 2, paragraphs 0016-0020, page 3, paragraphs 0042, 0043, page 4, paragraph 0047, page 6, paragraphs 0070-0072, page 7, paragraphs 0084, 0086, 0087).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/MD S ELAHEE/

MD SHAFIUL ALAM ELAHEE

Primary Examiner

Art Unit 2614

December 18, 2008